

The Alleged Species

The Action alleges the following Species:

- Species I: vibrating the gate in response to a monitored parameter
- Species II: heating the gate in response to a monitored parameter
- Species III: applying de-icing material to the gate in response to a monitored parameter
- Species IV: contacting a third party in response to a monitored parameter
- Species V: capturing image data in response to a monitored parameter
- Species VI: monitoring drive current
- Species VII: sensing resistance to movement
- Species VIII: sensing deposit of item
- Species IX: sensing removal of item
- Species X: sensing unexpected item

Applicants Provisionally Elect With Traverse

In response to the Action requiring species election, Applicants, as the requirement is best understood, provisionally elect with traverse the alleged Species VI (alleged as monitoring drive current). The Office acknowledges that at least claim 1 is generic. As the requirement is best understood, all claims 1-34 are readable on the alleged Species VI.

Reconsideration and withdrawal of the election requirement is respectfully requested. Applicants respectfully submit that the requirement is not legally proper and should be withdrawn.

The Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for election to be required. Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits. Applicants respectfully submit that the election requirement is not legally proper because the criteria for serious burden has not been met.

The Requirement is not legally proper as a reasonable number of species are permitted

Applicants are entitled to a reasonable number of species (i.e., more than one species). Even if it were somehow possible for the Office to show serious burden (which it hasn't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged by the Office, the alleged species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper
because a valid reason for species restriction is absent**

The "mutually exclusive characteristics" (MPEP § 806.04(f)) and the "relationship" (MPEP § 808.01(a)) of the alleged species have not been provided to Applicants. A valid reason why the alleged species are distinct species is absent in the Action.

In accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which *claim* recites limitations which are found in a first species but not in a second, while a second *claim* recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted "general test" of MPEP § 806.04(f). Thus, the Action procedurally fails to present a valid reason for the requirement.

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that the alleged species are prevented from being used in the same embodiment? Conversely, claims 2-13 are each in immediate dependent order. Where does the Action provide evidence that the other alleged species are specifically prevented from be used with alleged Species VI? Where does the Action provide a reason why the alleged Species VI and each of the other alleged Species are mutually exclusive species? Likewise, where does the Action provide valid reasons of mutual exclusivity for the other alleged species. The Action has not shown that each alleged specie cannot be used in an embodiment with another alleged specie. Rather, the Action's own allegations appear to be contrary to the general test for species being mutually exclusive.

The Action must show that each of I/II, I/III, I/IV, I/V, I/VI, I/VII, I/VIII, I/IX, I/X; II/III, II/IV, II/V, II/VI, II/VII, II/VIII, II/IX, II/X; III/IV, III/V, III/VI, III/VII, III/VIII, III/IX, III/X;

IV/V, IV/VI . . . IV/X; V/VI, V/VII . . . V/X; VI/VII . . . VI/X; VII/VIII . . . VII/X; VIII/IX, VIII/X; AND IX/X are mutually exclusive. The Action has not shown that the alleged species are prevented from being used in the same embodiment. The Action has not met the general test for mutually exclusive species. It follows that the Action has not met the test for a proper species restriction requirement. Thus, the requirement is improper and should be withdrawn.

Nor has the Office demonstrated where the alleged species occur in the claims, nor the common characteristic linking each of the alleged species. For example, what common characteristic links vibrating a gate (I) with contacting a third party (IV)? Likewise, how is monitoring drive current (VI) linked to sensing removal of item (IX)? Applicants respectively disagree with the Actions' allegations and descriptions of species. For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the requirement should be withdrawn.

The Requirement is not legally proper because it is incomplete/unclear

The Action does not meet the species restriction requirement criteria set forth in MPEP § 809.02(a). The Action does not clearly identify each of the alleged species *to which claims are restricted* in accordance with MPEP § 809.02(a). Where does the Action correspond the *claimed* subject matter to the alleged species? Where does the Action show where the alleged species occur in the claims? For example, where do the claims recite sensing resistance to movement (VII) or sensing unexpected item (X)? Again, where are each of the alleged species found in the claims?

The species restriction requirement does not properly describe the alleged distinct species. Nor are the alleged species clearly and properly presented. The Office has not indicated where the alleged species occur in the claims, nor the common characteristic linking the alleged species. The Action leaves Applicants the burden of properly responding to an unclear and improper requirement. Because the criteria for proper species restriction requirement has not been met by the Office, Applicants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a valid species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to allegations of species. The Action also appears to obfuscate the issues, because there is no proper species election requirement to be made. For these reasons it is respectfully submitted that the requirement is improper. As there is no valid basis for requiring the species election requirement, it is respectfully submitted that the requirement should be withdrawn.

Applicants, as the requirement is best understood, have provisionally elected with traverse. However, Applicants reserve all rights to change or modify their election based on the alleged species election requirement presentation being made a clearly understood and proper requirement.

Response to the Additional Comments

The Office indicates that generic claim 1 is directed to (1) analyzing a parameter and (2) performing an action in response. That is, the Action indicates that (1) and (2) are independent from each other. Yet the Requirement is based on each of the alleged species being directed to

either (1) *or* (2), instead of (1) and (2). It is unclear how a species solely directed to analyzing a parameter can share a common characteristic with a species solely directed to performing an action. By the Office's own admission the Requirement is improper.

Applicants respectfully submit that in their application "One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application" (37 CFR 1.75(c)). The Office confuses proper dependent claims with species. With the species restriction practice applied herein by the Office, every dependent claim in every application would be improperly restricted.

Conclusion

The species election requirement is respectfully traversed. The species election requirement is not proper. Therefore, it is respectfully requested that the species election requirement be withdrawn.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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